

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN K. HOWIE

Appeal No. 1996-0875
Application No. 08/169,918¹

ON BRIEF

Before JOHN D. SMITH, PAK and SPIEGEL, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 1-19.

Representative claims 1 and 17 are reproduced below:

¹ Application for patent filed December 20, 1993. According to the appellant, the application is a continuation-in-part of Application No. 07/968,775, filed on October 30, 1992, now abandoned.

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1. A nondigestible fat composition useful as a replacement for triglyceride fats or oil in foods, which composition has a Solid Fat Content profile slope between 70°F and 98.6°C [sic, 98.6°F] of from 0 to about -0.75% solids/°F and which composition comprises:

A. a liquid nondigestible oil having a complete melting point below about 37°C; and

B. nondigestible solid particles of a polyglycerol ester dispersed in said oil in an amount sufficient to control passive oil loss upon ingestion of said composition, said nondigestible solid particles having a complete melting point about 37°C, wherein the ester groups forming said polyglycerol ester are formed from long chain fatty acid radicals with at least about 40% of said long chain fatty acids being saturated and having at least 18 carbon atoms, wherein said polyglycerol esters have an Iodine Value of less than about 1, and wherein said nondigestible particles serve to impart to said composition a Thixotropic Area Value of about 10 kPa/sec or greater.

17. A food product comprising an edible substrate and form 10% to 100% of the nondigestible fat composition of Claim 1.

The reference of record relied upon by the examiner is:

Young et al. (Young)	5,085,884	February 4,
1992		

The appealed claims² stand rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1-50 in the Young patent.

² The appealed claims stand or fall together. See the brief at page 4.

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We affirm.

The subject matter on appeal is directed to a nondigestible fat composition useful as a replacement for triglyceride fats or oils in foods and a food product comprising an edible substrate (e.g. a potato chip) and the nondigestible fat composition. See appealed claims 1 and 17 reproduced above. The claimed composition comprises a liquid nondigestible oil and nondigestible solid particles of a polyglycerol ester dispersed in the liquid nondigestible oil. Importantly, for purposes of this appeal, the ester groups of the polyglycerol ester making up the nondigestible solid particles "are formed from long chain fatty acid radicals with at least 40% of said long chain fatty acids being saturated and having at least 18 carbon atoms" (appealed claim 1). Additionally, the nondigestible particles "serve to impart to said composition a Thixotropic Area Value of about 10 kPa/sec or greater" (appealed claim 1).

The patented claims of the Young patent which are the basis of the examiner's obviousness-type double patenting rejection define, in relevant part, the ester groups of a polyol fatty acid polyester which make up the solid particles

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(which are combined with a liquid nondigestible oil containing fat composition of a food) as comprising "a combination of:
(a) C₁₂ or higher unsaturated fatty acid radicals, C₂-C₁₂ saturated fatty acid radicals or mixtures thereof, and (b) at least about 15% C₂₀ or higher saturated radicals, wherein the molar ratio of (a) to (b) radicals is from about 1:15 to about 2:1." See patented claim 1 of Young.

We do not agree with appellant (brief, page 5) that the ester groups forming the solid polyglycerol ester particles of the fat composition defined by the appealed claims are significantly different from the corresponding ester groups of the polyol fatty acid polyester required by the patented claims of Young. Indeed, when the Young (a) to (b) ratio of fatty acid radicals is about 1:15, the ester groups forming Young's solid polyol fatty acid polyester are made up of predominantly "C₂₀ or higher saturated fatty acid radicals (emphasis added)" and thus meet the terms of appellants' claims that require the solid particles to be formed "from long chain fatty acid radicals with at least 40% of said long chain fatty acids being saturated and having at least 18 carbon atoms (emphasis added)." As evident from the

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nonlimiting claim language in question in the appealed claims, appellants' solid polyglycerol ester particles may be formed from a long chain fatty acid mixture of 60% unsaturated acids and 40% saturated acids. Contrary to appellants' arguments, we see no claim language in the appealed claims (which are defined by "comprising" terminology) which limits the ester groups of the polyglycerol ester component to only saturated long chain fatty acid radicals of C₁₆-C₂₆ fatty acids. Moreover, contrary to appellants' arguments in the brief at page 5, Young's predominantly saturated fatty acid polyesters would necessarily possess a low iodine value.

Appellants also emphasize that the "claimed invention" requires a specific thixotropic area which is set forth in appealed claim 1 as a "Thixotropic Area Value of about 10kPa/sec or greater (emphasis added)." The range of this value, however, overlaps with the range of the thixotropic value of "about 200,000 pascals/sec or less" in patented claim 1 of Young. Thus, although the herein appealed claims cover different subject matter from that of the patented claims in Young, the claims are not patentably distinct from claims in

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the Young patent, since the respective appealed and patented claims, when properly construed, cover common subject matter.

The examiner's rejection of the appealed claims based on the grounds of obviousness-type double patenting is sustained.

OTHER ISSUES

In the event of any further prosecution of this application, the examiner should reconsider the reapplication of the Young patent under 35 U.S.C. § 103 against the appealed claims. This patent qualifies as prior art against the presently appealed claims under 35 U.S.C. § 102(e). A rejection of the claims under this section of the statute was "dropped" by the examiner without explanation. See Paper No. 5 entered January 30, 1995. No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JOHN D. SMITH

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Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CAROL A. SPIEGEL)	
Administrative Patent Judge)	

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Karen F. Clark
The Proctor and Gamble Company
Winton Hill Technical Center
6071 Center Hill Avenue-Box 331
Cincinnati, OH 45224-1703

